

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

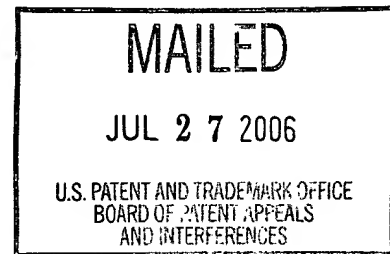
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte BRIAN A. LEETE

Appeal No. 2005-2753
Application No. 09/730,238

ON BRIEF



Before FLEMING, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, KRASS, JERRY SMITH and BARRETT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests rehearing and reconsideration of our decision of November 22, 2005, wherein we affirmed the examiner's decision rejecting claims 1-23 and 26-48 under 35 U.S.C. §103.

In addition, appellant requests an expanded panel for rehearing in accordance with Standard Operating Procedure 1 (Revision 12) based on an allegation of our Decision raising two issues of "exceptional importance."

The first alleged exceptional issue of importance is that our opinion did not discuss or distinguish the Federal Circuit cases cited by appellant, but, instead, cited other, many older, Federal Circuit cases than those cited by appellant.

The second alleged exceptional issue of importance is that our decision did not discuss or support the element of a reasonable expectation of success as an important element of a prima facie case of obviousness.

While we do not necessarily agree that these are “exceptional” issues of importance, we grant appellant’s request for an expanded panel to elucidate on our reasoning.

Appellant requests rehearing of all thirteen grounds of rejection. These grounds of rejection are listed at page 3 of our decision of November 22, 2005, and are also listed on pages 8-9 of the principal brief of March 11, 2005.

In particular, appellant asserts that our opinion overlooked or misapprehended the following four points:

A. Our opinion did not address the Federal Circuit cases cited by appellant of *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998); and *In re Kotzab*, 217 F. 3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) but provides another list of cases to support our analysis, with all but one of those listed cases older than the cases cited by appellant.

B. Our opinion did not discuss appellant's argument that the rejections did not cite evidence of a reasonable expectation of success and that this is a relevant factor in determining whether a prima facie case of obviousness has been established.

C. While there are thirteen different grounds of rejection to be reviewed on appeal, our opinion addressed only the first six grounds separately, dismissing the last seven grounds in a single paragraph. Appellant asserts that since the brief referred to each separate ground of rejection, so must our opinion.

D. Our opinion misapprehended appellant's argument that there is no clear and particular evidence of a suggestion or motivation to form the proposed combinations of references.

We will respond to these four points in the order listed by appellant. Points A and B correspond to the two issues which appellant submits to be issues of exceptional importance justifying review by an expanded panel.

A.

An allegation that certain cited Federal Circuit cases are newer than others does not refute the viability of the cases cited in our decision. We note that appellant does not assert that any of the decisions in the cases cited in our opinion have been overruled or that we have cited case law that does not apply.

Appellant's brief summarized the applicable law as follows (brief, pages 10-11):

A Federal Circuit opinion states that the suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art. [Footnote 3 citing MPEP § 2143 and *In re Vaeck* omitted.]

Multiple Federal Circuit decisions emphasize the need for the PTO to furnish evidence in support of claim rejections. For example, the Federal Circuit addressed citation of "basic knowledge or common sense" in rejections in *In re Zurko*:

"With respect to core factual findings in a determination of patentability, however, the Board [Board of Patent Appeals and Interferences] cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." [Footnote 4 to *Zurko* omitted.]

The Federal Circuit has particularly emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 U.S.C. § 103 in *In re Lee*:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.....The factual inquiry whether to combine references must be thorough and searching.....It must be based on objective evidence of record." [Footnote 5 to *In re Lee* omitted.]

The Federal Circuit stated that the "need for specificity pervades this authority" requiring a teaching, motivation, or suggestion to select and combine references. [Footnote 6 to *In re Lee* omitted.] The Federal Circuit has expressed this need for specificity in several cases:

"[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.....the showing must be clear and particular." [Footnote 7 to *In re Dembiczak* omitted.]

“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.” [Footnote 8 to *In re Rouffet* omitted.]

“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” [Footnote 9 to *In re Kotzab* omitted.]

Appellant then generally argued that the “final Office Action has not cited clear and particular evidence of record in support of a [or ‘this’] motivation to modify Herwig [and one or more of the secondary references] as is required by *In re Dembiczak* and *In re Lee*” (principal brief-pages 12, 14 (2 places), 15, and 16-17; similar language pages 16 and 25), or the “final Office Action has not cited clear and particular evidence of record in support of this [or ‘a’] motivation to combine Herwig [and one or more of the secondary references] as is required by *In re Dembiczak* and *In re Lee*” (principal brief-pages 18, 19, 20 (2 places), 21, 22, 23 (2 places), 24, and 25) and is improperly using hindsight “contrary to *In re Dembiczak*” (principal brief-pages 14, 16, 18, 20, 23, and 25) and cannot rely on common sense alone to support a rejection “as this is contrary to *In re Zurko*” (principal brief, pages 18 and 23).

Thus, appellant’s briefs did no more than provide a boilerplate citation of case law and then assert that the examiner’s rejection did not comply with that case law. That our opinion did not discuss the cases does not mean that we overlooked or disagreed with the more recent case law: the question is whether the obviousness conclusions in our opinion were explained based on concrete evidence in the record. The request for rehearing does not

address the merits of the reasoning in our opinion. We do not disagree with any of the cited case law, except for the requirement to show a reasonable expectation of success in electrical cases as discussed in connection with point B, *infra*. And, while the suggestion, teaching, or motivation to combine must be based on objective evidence of record, rather than common knowledge or common sense, the Federal Circuit recently made it clear that the suggestion does not have to be expressly stated in the references, but may be implicit from the prior art as a whole. See *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). The implication by appellant that there must be an express teaching in the references to make the proposed modification or combination is incorrect.

Our opinion relied on the concrete evidence provided by the applied references as required by *Zurko* in reaching our determination of obviousness of the instant claimed subject matter. For example, with regard to instant independent claim 1, we explained, at pages 7-9 of our opinion, how the structure of Herwig, together with Flannery's teaching of an internal power supply for the USB hub, would have led the artisan to connect power supply 112, in Herwig, to the USB hub 114, in Herwig, to provide a self-powered alternative to a USB cable provided power supply. We note that appellant has pointed to no error in our analysis in his request for rehearing.

Appellant does not state why our opinion does not comply with *Lee*'s requirement that the factual inquiry whether to combine references must be thorough and searching and must be based on objective evidence of record. Again, using our analysis of the applied

references and how they are applied against instant claim 1, at pages 7-9 of our opinion, we have, indeed, based our conclusion of obviousness on the objective evidence of record.

As we explained, with regard to claim 1¹, for example, Figure 3 of Herwig discloses a housing 110, a power supply 112 enclosed in the housing, a bus hub 114 enclosed in the housing, a downstream receptacle (the rectangular box at the top of 110, into which lines 106, 136, and 138 are connected) connected to both the power supply 112 and the bus hub 114, and wherein the downstream receptacle is coupled to a cable 90, 94 to couple power from the power supply 112 and data signals from the bus hub 114 to the cable, 90, 94, and to receive power and data signals from the cable 90, 94. In fact, the only portion of claim 1 not explicitly described by Herwig is that the power supply is coupled to the bus hub to supply power to the bus hub. But, it would have been clear to artisans that Herwig's bus hub 114 must receive power from some source in order to operate. It may very well be through cable 90, 94, since the cable is shown as being connected to "INTERFACE TO TERMINAL (POWER, LAN, AND USB)," but the power must be supplied from some power source.

In addition to the knowledge that the USB hub of Herwig must receive power from some source, Flannery described a power source for USB devices wherein such devices were "self-powered." See, for example, Figure 1A of Flannery wherein a remote hub is shown as having its own internal power source 108. Thus, the objective evidence provided by Herwig

¹ We take claim 1 as representative of the other claims of Group I (claims 1-4, 7, 11, 12, 16, 17, 19, 28-32, 39, and 41-43) since appellant does not argue these claims separately from one another and the claims will therefore stand or fall together. Note pages 12-14 of the principal brief wherein appellant argues the Group I claims together.

and Flannery established that a USB hub may have either an external or an internal power source. With this explicit knowledge provided by the applied references, the artisan viewing Figure 3 of Herwig, where there is disclosed a USB hub and a power supply 112 internal to the housing but external to the hub, would quickly have been led to provide a power supply for the USB hub 114. Since a power supply would have been known as necessary to power the USB hub 114, and there is already a power supply 112, internal to the housing but external to the hub, the skilled artisan would have been led to connect the power supply 112 to USB hub 114 since, if a power supply is not already provided internal to the USB hub, the power supply 112 would be the closest element from which to tap power in order to supply the power necessary for the correct functioning of USB hub 114.

It is our view that this analysis is a clear indication of “concrete evidence” in the record to support the findings of obviousness, within the dictates of *Zurko*. We note, again, that appellant has pointed to no specific perceived error in our analysis in his request for rehearing even though we clearly pointed out how we were applying the teachings of the references.

Appellant cites *Dembiczak* and *Vaeck* for the proposition that there must be clear and particular evidence of record in support of a motivation to modify Herwig according to Flannery. Once again, our explanation at pages 7-9 of our decision, as well as our elucidation *supra*, clearly explains how there is evidence in this record for combining the teachings of Herwig and Flannery. We note again that appellant has not pointed to one single perceived error in our analysis in his request for rehearing.

In citing *Rouffet* at page 11 of the principal brief, appellant recites that “[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.” At page 8 of our decision, we identified the principle that artisans would have recognized that the USB hub must be powered from *some* source. Having teachings, from Herwig and Flannery, that a power source may be in the USB cable, internal to the USB hub, or within the same housing as the USB hub, the skilled artisan would have been led to simply connect the already existing power supply 112, in Herwig, to the USB hub 114 as an alternative to the internal power source suggested by Flannery. We therefore concluded that the claimed combination was clearly suggested in the prior art and appellant has not alleged any particular error in our rationale in the request for rehearing.

At page 11 of the principal brief, appellant also cited *Kotzab* for the principle that “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” Again, reference to our opinion, at page 8, as explained *supra*, does indicate, in our view, particular findings as to the reason skilled artisans would have been led to modify one reference in accordance with the teachings of the other, in order to arrive at the instant claimed subject matter. Again, appellant has pointed to no perceived error in our reasoning.

With regard to the claims of Group IV (8 and 38, with claim 8 being representative) and Group VII (13 and 40, with claim 13 being representative), these claims define the cable as comprising various wires, including a “device power wire,” a “device ground wire,” a

“computer power wire,” a “computer ground wire,” and a “plurality of signal wires.”

At pages 16-17 and 19-20 of the answer, the examiner specifically pointed out where many of these limitations may be found in the combinations of Herwig, Flannery, and Kang (with respect to claim 8) and Herwig and Flannery (with respect to claim 13), but the examiner admitted that these combinations do not expressly teach a computer ground wire.

The examiner turned to Tsai for a teaching of a cable, pointing to cable system 300 in Figure 1, and identifying (see page 17 and 19 of the answer) where Tsai discloses a device power wire, device ground wire, computer power wire, a computer ground wire and a plurality of signal wires.

The examiner then concluded that it would have been obvious to have implemented the cable of Herwig, as modified by Flannery, or Flannery and King, using the cable system teachings of Tsai, “for the advantage of providing a compact and clean wiring in said housing, which is a [sic] *common sense* to one of ordinary skill in the art of electronics wiring” (answer-pages 17, 20) (emphasis added).

Thus, the examiner appears to have relied, at least in part, on “common sense” of the skilled artisan in reaching his conclusion of obviousness. Whereas *Zurko* and *Lee* warn against the use of “common sense,” per se, in making a determination of obviousness, the use of “common sense” is not precluded where evidence of record tends to support the allegation of “common sense.” While the suggestion, teaching, or motivation to combine must be based on objective evidence of record, rather than common knowledge or common sense, the

suggestion does not have to be expressly stated in the references, but may be implicit from the prior art as a whole. *In re Kahn*, 441 F.3d at 987, 78 USPQ 2d at 1336.

As can be seen by the examiner's explanation of the cable descriptions in the applied references, with regard to the rejections of the Group IV and Group VII claims, the examiner does not rely on "common sense" to provide evidence of obviousness. Rather, the examiner has relied on the evidence provided by the applied references, e.g., the cable of Tsai comprising a device power wire, a device ground wire, a computer power wire, a computer ground wire, and a plurality of signal wires, as the basis for providing for these wires in the cable of the Herwig device, as modified by either Flannery or by Flannery and Kang, using the term "common sense" to describe why the artisan would have been led to combine the teachings of these references which provide all of the evidence needed for making such a combination, rather than using "common sense" as the evidence itself.

Thus, we find unpersuasive appellant's allegation that, somehow, our decision was in error because we did not specifically discuss each and every one of the Federal Circuit cases cited by appellant. Once again, we do not disagree with these cases, but, more importantly, appellant has simply not pointed out how the application of these cases to the instant claimed subject matter and to our reasoning in holding such subject matter obvious, within the meaning of 35 U.S.C. § 103, is alleged to require a reversal of any of our findings and/or of our decision.

B.

With regard to a reasonable expectation of success, it is agreed, as stated in *Vaeck* and MPEP § 2143, that this may be a relevant factor in determining whether a prima facie case of obviousness has been established in some circumstances. Such a test is appropriate in chemical cases where results are often unpredictable. However, in mechanical and/or electrical cases, there is seldom any uncertainty as to the outcome of combining references.

Thus, in the instant case, we found, for example, that the USB hub must be powered from *some* source and that the skilled artisan would have been led to simply connect the already existing power supply 112, in Herwig, to the USB hub 114 as an alternative to the internal power source suggested by Flannery, in view of the teachings from the references that a power source may be in the USB cable, internal to the USB hub, or within the same housing as the USB hub. There is no doubt that connecting the power supply to the USB hub will work and, therefore, there is simply no question about “reasonable expectation of success.”

Hence, appellant’s argument anent “reasonable expectation of success” is not persuasive. It may be but one factor, and clearly not the only and deciding factor, as to whether certain claimed subject matter is obvious, within the meaning of 35 U.S.C. § 103. We have set forth in our opinion reasoning as to why the applied references would have suggested the instant claimed subject matter and appellant has failed to indicate, in the request for rehearing, any perceived error in our analysis or any reasons why there is no reasonable expectation of success.

C.

With regard to appellant's argument that we disregarded the last seven rejections (Grounds VII-XIII) with but a single paragraph in our opinion, we are unpersuaded of any error on our part. Appellant, in each ground, quoted from the final rejection and then alleged that the final rejection had not cited clear and particular evidence of record to support this motivation, that the rejection cannot rely on common sense alone (Ground VII), that the final rejection improperly used hindsight, and/or that it did not cite evidence of a reasonable expectation of success. None of these general allegations of insufficient evidence or improper hindsight attempt to point out the error in the examiner's specific rationale. Our general affirmance of the rejection of these claims is commensurate with the general non-specific nature of the arguments set forth by appellant. We need be no more specific in our rationale than appellant has been in the general denial of obviousness. While it is true that the examiner has the initial burden to establish a prima facie case of obviousness, once that case has been established (which it has in the instant case for the reasons set forth by us in our opinion), the burden shifts to appellant to argue, if he/she can, with specificity what the alleged errors in the examiner's case are perceived to be. A mere general allegation by appellant that there is a "lack of clear and particular evidence of record in support of a motivation to combine the references," in response to the prima facie case, is insufficient to rebut said prima facie case. The examiner set forth a prima facie case.

With regard to the Group VII claims 13 and 40, the examiner has established a prima facie case of obviousness by assessing the claimed subject matter, determining how it differs

from the combination of Herwig and Flannery (the difference is in no explicit showing of the computer ground wire in the Herwig/Flannery combination), providing a teaching of a cable having such a computer ground wire in Tsai, and providing a reason why the skilled artisan would have been led to modify the references to arrive at the instant claimed subject matter (“proving a compact and clean wiring in said housing”). See pages 19-20 of the answer. Appellant has provided no specific reason for alleging an error in the examiner’s rationale.

With regard to the Group VIII claim 14, the examiner has established a prima facie case of obviousness by applying Herwig, Flannery, and Tsai as before, recognizing that these references lack a teaching of the plurality of wires comprising a “twisted pair,” and applying Decuir (Figure 6) for such a teaching, finding that it would have been obvious to make the combination “for the advantage of supporting high speed version of USB,” citing column 5, lines 5-7, of Decuir. (Answer-page 20). Appellant has indicated no specific error in the examiner’s reasoning.

With regard to the Group IX claim 15, the examiner has established a prima facie case of obviousness by applying Herwig, Flannery, and Tsai as before, recognizing that this combination did not explicitly teach a plurality of signal wires comprising a “fiber optic channel,” and applying Sanchez (Figure 2A) for a teaching of an electro-optic interface system having such signal wires. The examiner reasoned that the artisan would have been led to make the combination “for the advantage of providing an electro-optic system of operation for communicating high aped [sic, speed] digital signals between two or more electronic systems (See Sanchez, col. 1, lines 57-60) without spreading electromagnetic noise, which is

well known to one of ordinary skill in the art of fiber optical communication” (Answer-page 21). Appellant has indicated no specific error in the examiner’s reasoning.

With regard to the Group X claims 21-23, the examiner has established a prima facie case of obviousness by explaining the various features of Herwig and Tsai (Answer-pages 21-22) and finding that it would have been obvious to have implemented the cable of Herwig in a cable system as disclosed by Tsai “for the advantage of providing a compact and clean wiring in said housing” (Answer-page 22). Appellant has indicated no specific error in the examiner’s reasoning.

With regard to the Group XI claim 26, the examiner has established a prima facie case of obviousness by explaining the various features of Herwig and Tsai (Answer-pages 23-24) and adding Decuir for the feature of a plurality of signal wires comprising a “twisted pair.” The examiner reasoned that it would have been obvious to combine these references “for the advantage of supporting high speed version of USB (See Decuir, col. 5, lines 5-7)” (Answer-page 24). Appellant has indicated no specific error in the examiner’s reasoning.

With regard to the Group XII claim 27, the examiner has established a prima facie case of obviousness by explaining the various features of Herwig and Tsai, recognizing that this combination did not explicitly teach a plurality of signal wires comprising a “fiber optic channel,” and applying Sanchez (Figure 2A) for a teaching of an electro-optic interface system having such signal wires. The examiner reasoned that the artisan would have been led to make the combination “for the advantage of providing an electro-optic system of operation for communicating high aped [sic, speed] digital signals between two or more electronic

systems (See Sanchez, col. 1, lines 57-60) without spreading electromagnetic noise, which is well known to one of ordinary skill in the art of fiber optical communication” (Answer-page 24). Appellant has indicated no specific error in the examiner’s reasoning.

With regard to the Group XIII claims 37 and 48, the examiner has established a prima facie case of obviousness by applying Herwig and Flannery as before, and adding Urade for a USB hub 11 (Figure 4), wherein a hub repeater 12 is connected to an upstream port (Root Port 13). The examiner explained that it would have been obvious to have included a hub repeater as in Urade, in the hub bus of Herwig, as modified by Flannery, “so as to manage port connectivity between a selected downstream functional device and a host computer connected to said upstream port (i.e., root port; See Urade, col. 3, lines 60-62)” (Answer-page 13).

The examiner then explained that the combination of Herwig, Flannery, and Urade did not expressly teach that the hub controller and hub repeater comprised memory stored instructions executable by a processor or logic gates or a programmable logic device (Answer-pages 24-25). The examiner turned to Silverman (Abstract and Figure 4) for a teaching of a configurable universal serial bus (USB), and indicated, at page 25 of the answer, where, in Silverman, the memory stored instructions, logic gates, and programmable logic device are found.

The examiner concluded that it would have been obvious to have included the configuration components of Silverman in the hub controller and hub repeater of Herwig, as modified by Flannery and Urade, “for the advantage of providing an improved technique for

effecting digital communications between said downstream devices (i.e., digital devices) and systems using different communication protocols (See Silverman, col. 4, lines 10-13).”

Appellant has indicated no specific error in the examiner’s reasoning.

Thus, the examiner has provided reasoning, amounting to a *prima facie* case of obviousness, in our view, for the rejections of each and every claim grouping, including Groups VII through XIII, and appellant merely alleges, generally, that the examiner has cited no clear and particular evidence of record in support of a motivation for the combinations of references and the examiner has cited no evidence of a reasonable expectation of success. Such general denials of the examiner’s reasonable explanations of the rejections, absent any *specifics* as to what appellant perceives as the error or errors in the examiner’s rationales, are not persuasive of nonobviousness.

Since appellant has not pointed to any *specifics*, regarding any perceived errors in the examiner’s rejections, preferring, instead, to merely generally allege a lack of “clear and particular evidence of record in support of this motivation to combine” the references and a lack of “evidence of a reasonable expectation of success of the proposed combination” (see page 20 of the principal brief with regard to the Group VII claims 13 and 40, page 21 with regard to the Group VIII claim 14, page 22 with regard to the Group IX claim 15, page 23 with regard to the Group X claims 21-23, and the Group XI claim 26, page 24 with regard to the Group XII claim 27, and page 25 with regard to the Group XIII claims 37 and 48), we find appellant’s allegations to be without merit.

While it is, indeed, an *argument* to allege a lack of clear and particular evidence of record in support of a motivation to combine the references, it is not persuasive in view of the rationale set forth in our opinion, and above, a rationale, we hasten to point out, which has not been convincingly rebutted by appellant's showing, or even an allegation, of any specific error in our reasoning.

Only arguments actually made by appellant have been considered by this Board. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37 (c)(1)(vii)].

D.

Appellant alleges that our opinion misapprehended appellant's argument that there is no clear and particular evidence of a suggestion or motivation to form the proposed combinations of references.

We did not misapprehend appellant's argument. The argument simply did not *specifically* point out the errors in the examiner's rationale as to why there was evidence to suggest the proposed combination. For example, following the examiner's rationale, we identified the principle that artisans would have recognized that the USB hub must be powered from *some* source. Having teachings, from Herwig and Flannery, that a power source may be in the USB cable, internal to the USB hub, or within the same housing as the USB hub, the skilled artisan would have been led to simply connect the already existing power supply 112, in Herwig, to the USB hub 114 as an alternative to the internal power source suggested by Flannery. We therefore concluded that the claimed combination was

clearly suggested in the prior art and appellant has not alleged any particular error in our rationale in the request for rehearing.

This is “clear and particular evidence of a suggestion” to make the proposed combination of Herwig and Flannery. Yet, appellant has pointed to nothing in the request for rehearing tending to negate our reasoning. If appellant has some basis for making this allegation of non-combinability, then appellant should have specifically indicated where such a basis is found.

It would appear from appellant’s general allegations of nonobviousness that perhaps appellant requires that each and every claimed element be specifically taught by the references, along with a specific teaching in the references for making a proposed combination before permitting such a combination. If so, that is not the test for obviousness, within the meaning of 35 U.S.C. § 103.

To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct, based on evidence of record. The requirement of such an explanation is consistent with governing obviousness law. *In re Kahn*, 441 F.3d at 987, 78 USPQ 2d at 1336.

We believe we have provided such “rationale, articulation, or reasoned basis” at pages 7-14 of our opinion, as well as in our elucidation of that reasoned basis *supra*.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, citing *Kotzab* at 217 F.3d 1365, 1370.

For the reasons set forth in our opinion, it is our view that the combinations of references applied by the examiner would clearly have suggested the instant claimed subject matter even if not explicitly set forth in the references. The nature of the problem to be solved by the instant invention, i.e., a power supply coupled directly to the bus hub to supply power to that bus hub, and the teachings of Herwig in providing a power supply external to the bus hub and Flannery in providing for an internal bus hub power supply, would clearly have suggested to the artisan a power supply being coupled to the bus hub to supply power to the bus hub, as claimed.

We have carefully considered appellant's request for rehearing. We grant the request to the extent that we have expanded the panel hearing this case and we have reconsidered our decision. However, the request is denied with regard to making any changes in our decision of November 22, 2005.

Appeal No. 2005-2753
Application No. 09/730,238

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

DENIED

Muallaf

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GARY V. HARKCOM
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GARY V. HARKCOM
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ERROL A. KRASS
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Lee E. Barrett
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EK/rwk

Appeal No. 2005-2753
Application No. 09/730,238

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